

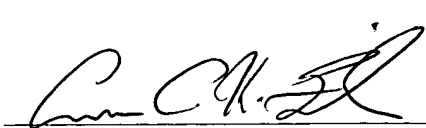


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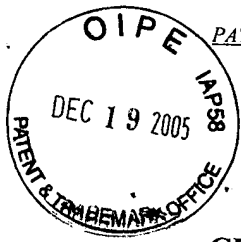
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR		Application Number	Filed
on <u>December 12, 2005</u>		09/605,818	June 28, 2000
Signature <u>Veronika S. Leliever</u>		First Named Inventor	
Typed or printed name <u>Veronika S. Leliever</u>		Jay S. Walker	
		Art Unit	Examiner
		3625	Mark A. Fadok
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Carson C. K. Fincham	
<input checked="" type="checkbox"/> attorney or agent of record.		Typed or printed name	
Registration number <u>54,096</u>		203.461.7017	
		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		December 12, 2005	
Registration number if acting under 37 CFR 1.34 _____		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

<input checked="" type="checkbox"/> *Total of <u>10</u> forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

Application Serial No. 09/605,818
Attorney Docket No. 00-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicants: Walker et al.
Application No.: 09/605,818
Filed: June 28, 2000
Title: SYSTEM FOR UTILIZING REDEMPTION INFORMATION

Attorney Docket No.: 00-001

Group Art Unit: 3625
Examiner: Mark A. Fadok

**PRE-APPEAL BRIEF REQUEST FOR REVIEW
of the rejections in the Final Office Action mailed September 13, 2005**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Final Office Action mailed September 13, 2005. No amendments are being filed with this request and this request is being filed with a Notice of Appeal. Review is requested for the reasons set forth in the remarks beginning on the following page.

REMARKS

I. Introduction

Claims 1-11, 38-42, and 51-55 are currently pending in the present application. Claims 1, 38, and 51 are independent. All claims stand rejected. In particular, (i) claims 1-11 stand rejected under 35 U.S.C. §101 as being allegedly directed to non-statutory subject matter, (ii) claims 1, 4-5, 7-9, 11, 38, 40-42, 51, and 53-54 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bruss, Robert, *No grey area: selling a site twice is illegal* (hereinafter "Bruss") in view of Lough, L.A., *System designed to grow with area* (hereinafter "Lough"), (iii) claims 2, 3, 39, and 52 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bruss and Lough in view of Official Notice, (iv) claims 6 and 55 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bruss and Lough in view of Kerch, Steve, Quick look at quickly selling in a tough market (herinafter "Kerch"), and (v) claim 10 stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bruss and Lough in view of U.S. Patent No. 5,761,647 (hereinafter "Broshy").

Although the finality of the Final Office Action mailed on September 13, 2005 (hereinafter the "Final Office Action") is inappropriate, at least because the Examiner has instituted new grounds for rejection based on new art of record (*i.e.*, Lough, Kerch, and Broshy), even in the absence of amendments to the claims, Applicants respectfully traverse these grounds for rejection as follows.

II. 35 U.S.C. §112, sixth paragraph "Notification"

After four Office Actions examining the currently pending claims, the Examiner has, at this late date, for the first time indicated confusion with respect to the application of §112, sixth paragraph to some of the pending claims. The Examiner has not indicated what characteristics of the claims, *or even which particular claims*, the Examiner believes to be associated with (or potentially associated with) §112, sixth paragraph. Accordingly, at least until the Examiner determines the nature of the claims in accordance with MPEP §2181, Applicants neither invoke nor preclude invocation of §112, sixth paragraph, to

any extent other than that already applicable as per the manner in which the claims have been drafted.

III. Claim Rejections under §101

The sole basis for rejecting claims **1-11** appears to be the Examiner's allegation that "[f]or a claimed invention to be statutory, the claimed invention must be within the **technological arts**", Final Office Action, pg. 3, last paragraph (emphasis added), and the Examiner's finding, that with respect to claims **1-11**, "it is unclear what feature uses the [sic] technology in a non-trivial manner." *Id.*, pg. 4, second paragraph

As explained by the Board of Patent Appeals and Interferences (BPAI) in the recent precedential opinion of Ex parte Lundgren, the purported requirement that all steps must be performed *per se* by use of a computer or other apparatus *is not* a proper basis for rejection. The Board expressly held that the alleged requirement that a claim must be "within the technological arts" has no legal basis:

Our determination is that **there is currently no judicially recognized separate "technological arts" test** to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection can not be sustained.

Ex parte Lundgren, Appeal No. 2003-2088, 9 (BPAI Oct., 2005); emphasis added.

The examiner's rejection under §101 in Lundgren was based solely on an alleged failure to suggest "computer, automated means, apparatus of any kind" and thus being "outside the technological arts." Accordingly, the Board reversed the §101 rejection.

Every one of claims **1-11** produces a useful, concrete and tangible result. In five examinations of claims **1-11**, the Examiner has never found or alleged otherwise. The Examiner relies on the same and only basis that was expressly rejected by the Board in Lundgren – an alleged failure to comply with a legally baseless requirement to recite a computer.

Applicants therefore respectfully request that the §101 rejections of claims **1-11** be withdrawn.

IV. Claim Rejections under §103(a)

All independent claims are directed to *arranging for a customer to redeem a product from a third party*. The Examiner has rejected all pending claims using the primary §103 of Bruss, which is associated with a real estate agent “arranging” for a buyer to **purchase a house** from a seller, which is certainly the general nature and business of a real estate agent. The Examiner has not explained, however, how the purchase of a house is related to, much less equivalent to, the redemption of a product. Applicants point out that “redemption” is not equivalent to a “sale”, and “real estate” is not a “product”. Indeed, real estate has even attained a separate treatment in the law as being recognized as unique – evidenced by the specific performance enforceability of real estate contracts (*e.g.*, as associated with Bruss).

Further, all independent claims are generally directed to *receiving, via an electronic communication network, information relating to a redemption of the product by the customer*. The Examiner alleges that Bruss teaches such a limitation. Bruss, however, merely describes the well-known Multiple-Listing Service (MLS) used by real estate agents, and describes that agents may provide “comparables” to buyers. Bruss does not describe receiving information associated with the redemption of a product. Bruss does not even describe receiving information associated with consummated real estate sales. Applicants note that such information was not generally available in the MLS system at the time of invention, and real estate agents had to consult separate public records (*e.g.*, at a town hall) to obtain such information. Bruss does not describe otherwise.

Lough, Kerch, and Broshy simply fail to make up for the deficiencies of Bruss. None of these references, for example, teach or suggest the above-cited limitations of the pending claims. Further, even if some combination of the references did teach all of the limitations of the pending claims (which Applicants reiterate is not the case), the Examiner has failed to point to a specific motivation in either the references or in the art that would have led one skilled in the art to make such a combination. In support of motivation to make the alleged combinations, the Examiner merely provides recitations of broadly categorized potential benefits including, for example, to “increase revenue”, to “relieve anxiety”, and to “provide useful information”. Such broad and conclusory

statements fall far short of meeting the Examiner's initial burden of establishing a *prima facie* case for obviousness.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness at least because the Examiner has not shown how any of the cited references (*i.e.*, Bruss or the newly-cited references of Lough, Kerch, and Broshy) teaches or suggests the limitations of (i) *arranging for a customer to redeem a product from a third party*, or (ii) *receiving, via an electronic communication network, information relating to a redemption of the product by the customer*, nor pointed to any motivation that would have led one skilled in the art to make the proposed combinations of the cited references. Applicants therefore respectfully request that the various §103(a) rejections of all pending claims be withdrawn.

V. Conclusion

At least for the foregoing reasons, it is submitted that all claims are clearly in condition for allowance and Pre-Appeal Brief Review is requested to avoid the unnecessary expense of preparing an Appeal Brief in relation to the current rejections.

If there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via e-mail at cfincham@walkerdigital.com, at the Examiner's convenience.

Respectfully submitted,

December 12, 2005
Date



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